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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,221	04/19/2004	Thomas A. Lile JR.	0617CG.030391	2904
35979	7590	03/14/2006	EXAMINER	
BRACEWELL & GIULIANI LLP			BONK, TERESA	
P.O. BOX 61389			ART UNIT	
HOUSTON, TX 77208-1389			PAPER NUMBER	
			3725	
DATE MAILED: 03/14/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,221

Applicant(s)

LILE ET AL.

Examiner

Teresa M. Bonk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-17 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,12 and 13 is/are rejected.
- 7) ☒ Claim(s) 3 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 9 of copending Application No. 11/288998.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Claims 4-7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-7 of copending Application No. 11/288998. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-2, 4-10, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang (US Patent 5,778,472). Lang shows the same tool, having a body, an intermediate portion, a terminal portion, a finger, and a first pocket between the terminal portion and the finger. The three above-mentioned portions are co-planar and define a continuous flat blade.

Lang also shows a finger extending from the second intersection at an angle that is out of plane with respect to the continuous flat blade and a notch formed on an inner edge of the body that is generally rectangular. (See attached figures on page 4 of this Office Action.)

Regarding claims 4 and 12, the intermediate angle is 60 degrees, the terminal angle is 90 degrees, and the finger angle is 90 degrees, since the claims do not define lines to make the angles; therefore, Lang does define arbitrary lines within each of those portions.

Regarding claims 5, 6, and 13, there is a first width and length on the body, second width and length on the intermediate portion, a third width and length on the terminal portion. The

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second width is greater than the first width and the third width is less than the first width. The second length is less than the first length and the third length is greater than the second length.

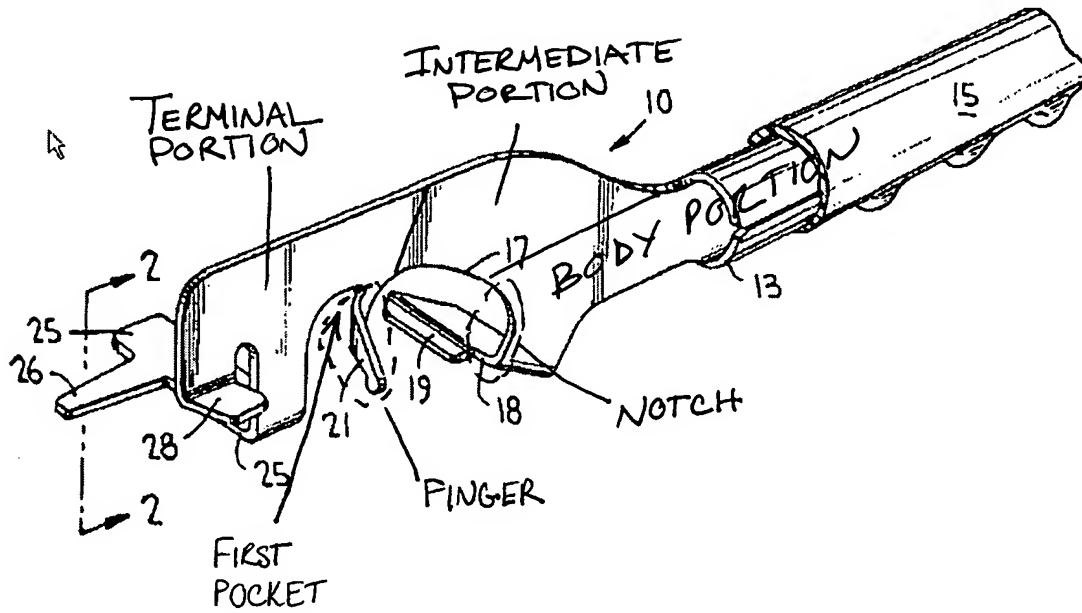


Figure 1: Lang (US Patent 5,778,472)

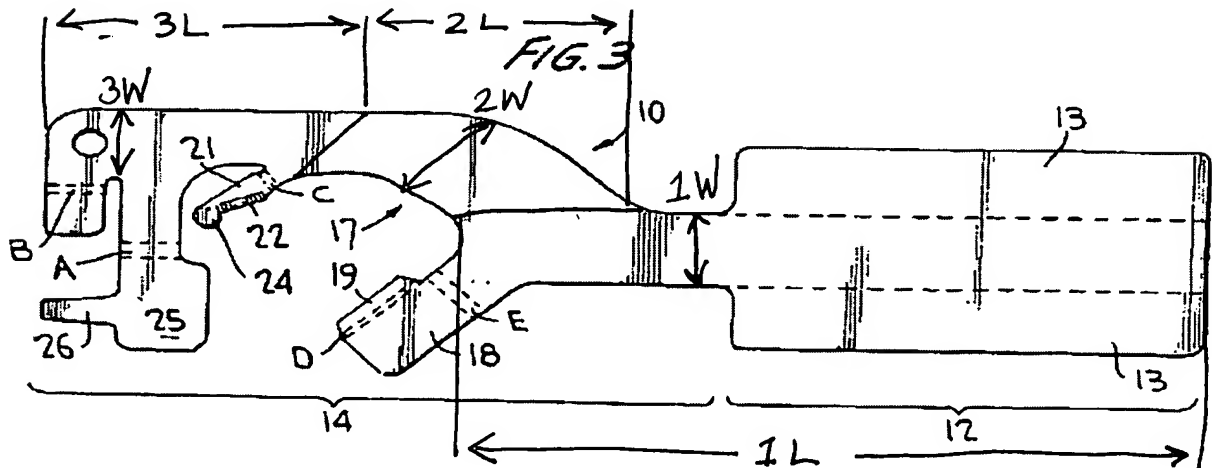


Figure 3: Lang (US Patent 5,778,472)

Allowable Subject Matter

5. Claims 3 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-17 are allowed.

It is in the opinion of the examiner that the art of record neither anticipates nor renders obvious "...a concave recess formed in an outer edge of the terminal portion adjacent to the second intersection, the concave recess having a radius of curvature that is adapted to receive a portion of a mounting clip" and "...seating the fence wire in a first pocket in the tool and one of the ends in a recess in the tool" in combination with the rest of the claimed limitations set forth in the independent claims.

Further searching by the examiner yielded additional prior art as follows:

Cooper (US Patent 791,009) discloses a hand tool having a body, intermediate, and terminal portions with a rectangular finger (19). However, this reference does not disclose that the above-mentioned portions are co-planar, defining a continuous flat blade.

McNulty (US Patent 584,3969) discloses a tool having several portions with a finger and a concave recess (12) at the tip of the tool.

However the above prior art fails to disclose a reasonable combination of "...a concave recess formed in an outer edge of the terminal portion adjacent to the second intersection, the concave recess having a radius of curvature that is adapted to receive a portion of a mounting clip" and "...seating the fence wire in a first pocket in the tool and one of the ends in a recess in

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the tool.” Therefore, it is concluded by the examiner that claims 14-17 of the present invention are allowable.

Conclusion

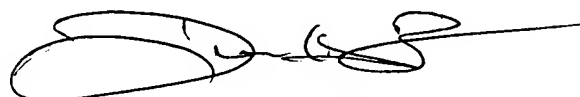
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are further shown the state of the art: US Patents 807,380; 6,199,452; 1,005,213; 886,913; 1,015,503; 3,890,912; 5,036,578; 2,484,278 and 526,718.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa M. Bonk whose telephone number is (571) 272-1901. The examiner can normally be reached on M-F 7:30AM - 5PM with alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-9900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Teresa M. Bonk
Examiner
Art Unit 3725



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
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